

REMARKS

The Official Action of January 24, 2008, has been carefully reviewed. The Applicant respectfully requests reconsideration of the application in view of the following remarks. Claims 34-47 have been canceled without prejudice and rewritten for presentation as new Claims 48-60 for convenience in entering this amendment. Support for this amendment is found in the Specification e.g. paragraph 0009 to paragraph 0020, and the claims of the application as filed.

1. Claims 48-60 are pending in the application.
2. Claims 38-42 stand rejected under 35 U.S.C. 112, second paragraph, for indefiniteness. The Examiner was concerned that Claims 38-42 did not fall within the scope of Claim 34. Although Applicants respectfully assert that the specification fully enables such claim, in the interest of compact prosecution, the definitions of "Y" in Claims 38, 39 and 40 have been incorporated into Claim 34. Accordingly, the rejection of Claims 38-42 under 35 U.S.C. § 112, second paragraph, for indefiniteness has been overcome.
3. Claim 47 stands rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Although Applicants respectfully assert that the specification fully enables such claim, in the interest of compact prosecution, Claim 47 has been canceled without prejudice. Accordingly, the rejection of Claim 47 under 35 U.S.C. § 112, first paragraph, for lack of enablement has been rendered moot.
4. Claims 34-37, 45 and 46 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Wood et al. Applicants respectfully traverse this rejection and submit that Wood et al. does not disclose each and every element of the claimed invention. In particular, Wood et al. require that the heteroaryl group (i.e. benzodiazepin) is directly attached to the acetamide. In contrast, in the present claims as amended, the heteroaryl group is attached to the amide of formula IV by an alkyl group (i.e. "q" is other than zero). Accordingly, the rejection of Claims 34-37, 45 and 46 under 35 U.S.C. § 102(b) as being anticipated by Wood et al. is untenable and should be withdrawn.

5. Claims 34-37, 45 and 46 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Ohki et al. Applicants respectfully traverse this rejection and submit that Ohki et al. does not disclose each and every element of the claimed invention. Ohki et al. disclose the specific compound 1-[4-(4-piperidinopiperidin-1-yl)benzoyl]benzotriazole-3-oxide as a synthetic intermediate. In contrast, the present claims as amended do not generically embrace this specific compound. Accordingly, the rejection of Claims 34-37, 45 and 46 under 35 U.S.C. § 102(b) as being anticipated by Ohki et al. is untenable and should be withdrawn.

6. Claims 34-37, 43, 45 and 46 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Goel et al. Applicants respectfully traverse this rejection and submit that Goel et al. does not disclose each and every element of the claimed invention. Goel et al. disclose the specific compound 6-[p-(4-piperidinopiperidin)phenyl]-1,2-dihydro-2-oxonicotinonitrile and the specific compound 6-[p-[4-(1-pyrrolidinyl)piperidino]phenyl]-1,1-dihydro-2-oxonicotinonitrile as synthetic intermediates. In contrast, the present claims do not generically embrace either of these specific compounds. In the present claims, the group "Y" is an amide of the specified structure; not an oxonicotinonitrile group. Accordingly, the rejection of Claims 34-37, 43, 45 and 46 under 35 U.S.C. § 102(b) as being anticipated by Goel et al. is untenable and should be withdrawn.

7. Claims 34-37 and 45-47 stand rejected under 35 U.S.C. 102 (e) as being anticipated by Apodaca et al. Applicants respectfully traverse this rejection and submit that Apodaca et al. does not disclose each and every element of the claimed invention. Apodaca et al. disclose certain compounds which have a phenyl ring substituted with R³, R⁴ and R⁵. None of the definitions of R³, R⁴ and R⁵ (page 6, lines 14-18) include an amide of the specified structure comparable to "Y" in the present claims. None of the specific compounds referenced by the Examiner (e.g. examples 50-54) possess a phenyl-amide group. Accordingly, the rejection of Claims 34-37 and 45-47 under 35 U.S.C. § 102(e) as being anticipated by Apodaca et al. is untenable and should be withdrawn.

8. Claims 34-37, 39, 45 and 46 stand rejected under 35 U.S.C. 102 (e) as being anticipated by WO 04/069792. Applicants respectfully traverse this rejection and submit that WO 04/069792 does not disclose each and every element of the claimed invention. In particular, the present claims require that the definition of "Y" wherein "q" is other than zero (0). Accordingly, the rejection of Claims 34-37, 39, 45 and 46 under 35 U.S.C. § 102(e) as being anticipated by WO 04/069792 is untenable and should be withdrawn.

9. Claims 34-37, 43 and 45-47 stand rejected under 35 U.S.C. § 103(a) as being obvious over Apodaca et al.

The Applicants respectfully traverse this rejection and provide the following comments. The Applicants respectfully assert that Apodaca et al. does not disclose or suggest the claimed invention. Nor would Apodaca et al. have motivated or enabled one skilled in the art to employ the subject compounds in accordance with the claimed invention. Apodaca et al. would have taught away from the present invention. Moreover, in view of the state of the art, one skilled in the art would have been discouraged from the compounds of the claimed invention.

Apodaca et al. disclose certain compounds in which "L" is a direct bond (to form a bipiperidiny phenyl group) wherein the phenyl ring is substituted with R^3 , R^4 and R^5 . The definitions of R^3 , R^4 and R^5 include "G" wherein "G" is " L^2Q " wherein "L" is unbranched - $(CH_2)_n$ - wherein n is an integer from 1 to 7 (page 6, lines 14-18). None of the definitions of R^3 , R^4 and R^5 in Apodaca et al. include an amide directly attached to the phenyl ring. The compounds of Apodaca et al. are bipiperidiny phenyl compounds wherein the phenyl ring is substituted with a straight chain alkyl group, not an amide group.

In contrast, the compounds of the present claims possess an amide as the group "Y" attached directly to the phenyl ring, which are structurally distinct from the compounds of Apodaca et al. Apodaca et al. does not generically or specifically teach the compounds of the present claims which have an amide group attached directly to the phenyl ring. None of the specific compounds of Apodaca et al. referenced by the Examiner (e.g. examples 50-54) possess an amide group attached directly to the phenyl ring.

Applicants respectively submit that there would have been no motivation nor guidance for one of ordinary skill in the art to have selected the compounds of Apodaca et al. and then to have modified such compounds to prepare the instant compounds.

Accordingly, Applicants respectfully submit that the rejection of Claims 34-37, 43 and 45-47 under 35 U.S.C. § 103(a) as being obvious over Apodaca et al. is untenable and should be withdrawn.

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Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

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